

### REMARKS

In reply to the office action mailed March 26, 2003, Applicants added new claim 27. Please consider the following remarks.

The pending claims recite a skateboard capable of undulating self-propulsion. The skateboard includes a front footboard, a rear footboard and an elongated strut connecting the two footboards. The footboards each include an elongated footpad, a single wheel mounted to the footpad, and a pivot joint connecting the footpad to the strut. The pivot joint has a pivot axis substantially perpendicular to the top surface of the footpad, and the wheel is the principal support for the footboard with respect to the ground. In some embodiments, for example in new claim 27, each pivot axis is positioned in-board of each wheel.

Claims 14-17, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,428,351 to Yu ("Yu")<sup>1</sup> and in further view of U.S. Patent No. 6,428,022 to Namiki ("Namiki"). Yu discloses a skate board combination that includes freely rotatable foot supports 20 connected through a beam 10. Attached to foot supports 20 are two axles 12, each of which includes two wheels 13. (See Yu, Fig. 1 and the paragraph bridging col. 1 and 2.) Nothing in Yu teaches or suggests a skate board combination having a single wheel mounted to a footpad as recited in the pending claims.

Namiki discloses a skateboard having inline skate wheels. The skateboard includes a platform 10 along with a front wheel truck 12 and a rear wheel truck 14, both of which are mounted on the underside of the platform 10. (See Namiki, Fig. 1 and col. 4, lines 58-63.) Unlike the skateboard recited in the pending claims, where the front wheel and rear wheel are each mounted to a footpad that can pivot independently, the wheels of Namiki are mounted to a single platform, which is a generally conventional skateboard type platform. (See Namiki, col. 4, lines 66-67.) Nowhere does Namiki teach or suggest mounting the front and rear wheels to

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<sup>1</sup> Although the Office Action lists the U.S. Patent Number for Yu as 5,428,002, Applicants believe this is an inadvertent typographical error. U.S. Patent Number 5,428,002 is awarded to Palefsky et al. and is titled "Composition of low type III content human placental collagen." Therefore, Applicants believe the Yu should be properly cited as U.S. Patent No. 5,428,351, which is awarded to Yu and is titled "Skate Board Combination."

footpads that can pivot independently as recited in the pending claims. Instead, Namiki notes that "(o)ne of the important aspect of the invention is the fact that both of the front and the rear wheels of the skateboard will *turn relative to the platform* in order to obtain a turning direction for the skateboard. (See Namiki, Col. 7, lines 6-9. *Emphasis added.*) Namiki describes this type of turning movement being as analogous to that of a surfboard. (See Namiki, Col. 6, lines 48-60.)

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some *teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.* (See MPEP, §2143.01. *Emphasis added.*) Motivation cannot come from the invention itself. (See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072 (Fed. Cir. 1993).

While the Examiner asserts the following:

It would have been obvious to one having ordinary skill in the art at the time of the invention to have provided the pivoting skateboard of Yu with the single wheels of Namiki in order to allow the skateboard to tilt at greater angles allow a decrease in turning radius. (See Office Action, p. 3, first full paragraph.)

nothing in the art of record supports such an assertion. Stated differently, nothing in either Yu or Namiki would have motivated one skilled in the art to modify the skate board combination of Yu such that each rotatable foot support is mounted on a single wheel.

Rather, the only suggestion to decrease the turning radius by mounting independently pivoting footpads over a single wheel, as suggested by the Examiner, is in the invention itself. Because no such teaching or suggestion is found in the art of record, Applicants assert that the Examiner is improperly "using hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988). Applicants therefore request that the rejection be withdrawn.

Claims 19-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu and Namiki and in further view of U.S. Patent No. 4,082,306 to Sheldon ("Sheldon"). Sheldon discloses a skateboard having a front platform separate and spaced from a rear platform. To each platform is attached a relatively conventional flexing wheel assembly with axle. (See Sheldon, Abstract.) Nowhere does Sheldon teach or suggest a single wheel mounted to each platform as recited in the pending claims. Without such a teaching or suggestion, the disclosure of Sheldon does not cure the deficiencies of Yu and Namiki. Accordingly, the combination of Yu, Namiki and Sheldon do not support a *prima facie* case of obviousness. Applicants therefore request that the rejection be withdrawn.

Applicants have presented new claim 27, which recites a skateboard including two footpads with a single wheel mounted to each footpad. Claim 27 further requires the single wheel be mounted to the footpad via a wheel-mounting bracket integral with or attached to the footpad and that the pivot joint have a pivot axis substantially in-line with the single wheel. None of the cited references Yu, Namiki, or Sheldon teach or suggest such a configuration of the wheel or pivot joint. Accordingly, for at least this reason, none of Yu, Namiki, or Sheldon, either alone or in combination, render claim 27 *prima facie* obvious.

Applicants believe that the application is in condition for allowance, which action is requested.

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Enclosed is a \$510 check for the Petition for Extension of Time fee and a \$100 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

March 15, 2005

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